



Image 1 ~~AS 11/16/16 \$~~

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Armando R. Lopez

Serial No.: 10/051,994

Filed: January 22, 2002

Title: Skin Protective

Examiner: Michael G. Hartley

Group No: 1616

To: Mail Stop Appeal Brief Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

December 6, 2003

**Appellant's Brief on Appeal Under 37 C.F.R. 1.192**

TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

The Appeal Brief is submitted in furtherance of the Notice of Appeal date-stamped as received by the USPTO on Nov 3, 2003.

The applicant appeals from the Final Rejection of the Examiner dated August 5, 2003 of claims 1-4, 6-13, 17 and 18 of the above-identified application which is believed to be in error and should be reversed.

A printed copy of the claims in Appeal is appended as Appendix A.

12/11/2003 DTESSEN1 00000048 10051994

01 FC:2402

165.00 OP

**Identification of Real Party In Interest**

The real party in interest in this appeal is the named inventor, who remains the owner of the patent application.

### Related Appeals and Interferences

There are no pending appeals or interferences involving any related cases.

### Status of Claims

The total number of claims pending in the application are 14.

Claims 1-4, 6-13, 17 and 18 were rejected and are on appeal.

Claim 1 is the sole independent claim and was amended from its original submission.

Claims 5 and 14-16 were cancelled.

### Status of Amendments

No amendments were submitted after Final Rejection.

### Summary of the Invention

The Applicant's invention is directed to skin protective compositions for topical application to the skin to prevent contact with and passage to the skin of toxic chemicals and irritants, as for example used in the hair dressing industry. The compositions of the invention are readily removable from the skin by the application of water. The compositions comprise a cosmetic vehicle or base and about 1.0 to about 10% by weight of a lathering surfactant.

The toxic, irritating or staining chemicals are generally found in the reagents used by beauticians, cosmeticians and the like in bleaching, dyeing, and permanent waving

and straightening human hair (see pages 1-5 of the application). The compositions of the invention protect the skin from contact with the harsh and irritating chemicals by serving as a passive but protective barrier between the skin and any toxic or irritating agent in the bleach, dye, waving or straightening formulation being applied to the hair. The ready removal of the barrier compositions merely by application of water, is achieved by incorporating into the composition provided in the form of a cream, lotion, aerial spray, ointment, gel, film forming liquid a small amount i.e. about 1.0 to about 10% by weight of a lathering surfactant.

The specification contains a very complete disclosure of the cosmetic vehicles or bases that may be utilized as well as of suitable lathering surfactants.

#### Issues Presented for Review

Claims 1-4, 6-12, 17 and 18 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Noll et al, in view of Guck and evidenced by McAtee et al.

Claim 13 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Noll et al in view of Guck and as evidenced by McAtee et al "as applied to claims 1 and 3 above" and further in view of Kelly et al. (No specific application to Claim 1 and 3 can be found.)

#### Grouping of Claims Under Rejection

Claims 1 to 13 are deemed to stand or fall together on the same arguments for patentability.

Claims 17 and 18 are deemed to stand or fall together on the same argument for patentability.

Appellants' Arguments

1. Rejection of claims 1 to 4, 6 to 12 and 17 to 18 under 35 U.S.C. 103 (a) over Noll et al, in view of Guck and evidenced by McAtee.

The Examiner relied on Noll et al as teaching "protective compositions in the form of suspensions, emulsions, lotions, ointments and aerosol gels which form a film on the skin effective as a topical barrier, said film being easily removable by washing."

The Examiner admits that Noll et al do not teach a lathering surfactant present in an amount of about 1 to 10% by weight but relies on Guck to cure this omission.

First the Noll et al compositions are not taught or suggested for the same or a similar purpose as herein stated by the applicant. One application of the Noll et al compositions is as set forth in col. 12, lines 39 et seq. "to help protect health care workers (i.e. nurses, doctors, technicians)... from infectious contact with another person's bodily fluids... some of which carry fatal infections (i.e. the HIV or AIDS virus)..." Another application "for health care applications, the composition of the invention both coats the skin with a protective barrier that inhibits infection from entering the body through the skin, and kills infectious organism/viruses before they enter the body. The composition also coats and seals wounds with a protective barrier so as to prevent infection. To accomplish these applications, the protective skin compositions contain as a critical ingredient an antimicrobial compound. As stated at col. 13, lines 50 et seq. "the protective film is removed from the worker's skin upon completion of the task. For this

purpose, the film of the invention must be readily removable, preferable by washing it from the skin with soap and water, to remove any residual contamination.” The exact language appears in the abstract “Once a medical operation is completed, the film formed from the dried cream can be washed off with soap and water.” At col. 13 lines 28 et seq., Noll et al recites ‘the base composition dries in a short time to form a film on the skin effective as a topical barrier against bodily fluids, i.e., that substantially prevents the contaminating fluids from reaching the skin. In addition, the film contains the antimicrobial agent in an amount effective to kill one or more types of infectious organisms, and can be removed with soap and water.’ (underlining ours) It is submitted that Noll reinforces the nonobviousness of the instant invention, incorporation into the barrier composition of a foaming surfactant in the low amounts indicated for facilitating removal of the barrier coating.

The Examiner relies on Guck as teaching “compositions for skin protection comprising 1-3% of foaming surfactants such as sodium lauryl ether sulfates... (and that those) are used for reducing the surface tension.” McAtee et al is additionally relied on by the Examiner for its teaching that “lowering of surface tension leads to better softening and breaking up of the lipid and silicone base of the skin products and thus, to improved removal of the lipid- and silicone-containing products from the skin.” The Examiner goes on to conclude that it would have been obvious to the skilled in the art to modify the compositions of Noll et al, such that to employ 1-3% of sodium lauryl ether sulfates of Guck. Further the Examiner continues, that those skilled in the art would be motivated to do this to obtain readily removable skin protecting compositions as suggested by McAtee et al.

Guck is specifically directed to foam compositions. These foams derived from aqueous emulsions are designed to include “(a) fatty acid esters with good skin toleration for spreading on the skin and forming a water-impermeable layer; (b) polyvalent alcohols for the stable dispersion of active agents and regulation of the humidity of the skin; (c) emulsifiers to improve foam stability; and (d) surfactants. The foam comprises a stearate ester; 5-10% myristic or palmitic acid; 1-3% glycerol, propylene glycol or polyethylene glycol; 1-3% palmitate ester or sorbitan ester; 1-3% sodium lauryl ether sulphate or amphoteric surfactant; 1-5% liposomes; 5-10% vehicle; and the rest water.” The skin protecting foams are applied to the skin and are removed therefrom by “mehrmaliges intensive waschen” (page 3, line 14 after the table), i.e. multiple intensive washings (translation by the undersigned). See page 6 of the translation “The skin protective foam can be removed by repeated intensive washing.”

First there is no recognition in Guck that the surfactant serves other than in forming the foam. There is no suggestion other than based on hindsight that the surfactant is to simplify the removal of the composition. Both Noll et al and Guck require washing with soap or multiple intensive washings.

McAtee is directed to a method for removing lipid and silicone based compositions, i.e., make-up from skin by applying a cleansing composition comprising a lathering surfactant and water. The lathering surfactant is present in an amount of from 5 to 74.5% and the water in an amount of about 25 to 94.9%. Applying a cleansing composition for the purpose of removing dirt, make-up, oil and the like is not comparable, i.e., analogous to applying a barrier protective coating which in the case of the invention is easily removed with water or in the case of Noll et al removed with soap and water and

in the case of Guck by repeated intensive water washing. In McAtee, it is the removal agent. Furthermore in McAtee, we have water and surfactant, the later in amounts of up to about 75%.

2. Rejection of Claim 13 under 35 U.S.C. 103 (a)

Claim 13 has been rejected on the above combination of references in view of Kelly et al (35 U.S.C. 103 (a)) as teaching the lipids of claim 13. The Examiner considered that it would have been obvious to use the lipids of Kelly et al for composition of Noll et al for their art-recognized purpose.

It should first be noted that the Examiner has admitted that Noll does not include surfactants so that the use of the lipids if this were proper would still fail to teach or suggest the invention.

It is further noted that claim 13 of the application is directed to a listing of preferred lipids. In the absence of any teaching of the basic invention, Kelly adds nothing further to the above combination of references.

The Examiner has reached an improper conclusion that an invention is unpatentable because "obvious," by reading back into the prior art the teachings of the invention which came later.

The U.S. Supreme Court has cautioned against "slipping into the use of hindsight" and urged courts "to resist the temptation to read into the prior art the teachings of the invention in issue." *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 USPQ 459, 474 (1966). For example, impermissible "hindsight" is using knowledge of the solution to



determine that the answer to the technical problem was "obvious," whereas to one without knowledge of the solution, the answer was not "obvious" at all.

An example of the impermissible use of hindsight is to combine pieces of the prior art to argue that a combination invention is obvious. There must be something in the prior art that suggested the combination of these particular prior art devices and processes other than the hindsight gained from knowing that the inventor chose to combine these particular things in this particular way. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

Furthermore, evidence indicating that what the inventor did was obvious to try does not meet the test that the invention was obvious in the sense of Patent Code § 103.

### Conclusion

In summary, the Examiner's rejections are not well founded and not in accordance with the precedents established by the Board of Appeals and the Federal Circuit Court of Appeals. Accordingly the Final Rejection of claims 1-4, 6-13, 17 and 18 should be reversed.

Respectfully Submitted

  
Evelyn M. Sommer

Attorney for Applicant

Registration No. 19, 603

825 Third Avenue 30<sup>th</sup> floor

New York, NY 10022-7519

Phone: 212-527-2657

Fax: 203-358-0795

### Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the 8<sup>th</sup> day of Dec, 2003.

